

## **REMARKS**

Claims 1 and 3-23 are currently pending in the Application. Claims 1 and 22 are amended. In response to the Notice of Non-Compliant Amendment mailed May 15, 2009, Applicant respectfully includes the text of withdrawn claims 24-29 in the above claim listing. The Examiner's particular rejections are now addressed in turn.

### Rejections under 35 U.S.C. 103(a)

Claims 1, 3-10 and 16-23 are rejected under 35 U.S.C. §103(a) as allegedly being obvious in view of U.S. Patent No. 5,119,833 to Powers and U.S. Patent No. 6,408,981 to Smith taken in combination with non-patent literature in the name of Baril and non-patent literature in the name of Cut Smart.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally the prior art reference(s) must teach or suggest all the claim limitations. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d 1016, 1023 (Fed. Cir. 1996).

Applicant's amended claim 1 recites *inter alia*,

“cutting the sheet through the thickness in a direction generally orthogonal to the length...severing the earplug from the sheet by said cutting and said maneuvering wherein said maneuvering comprises a substantially circular displacement of the earplug relative to said water stream, and wherein said cutting comprises traversing circular patterns on the sheet to sever the earplug from the sheet, the earplug being substantially cylindrical in shape.”

Powers, taken on its own or in combination with Smith, Baril, and Cut Smart, does not teach a severing of an earplug from a sheet via a cutting and a maneuvering that comprises traversing circular patterns on the sheet with a water jet and a substantially circular displacement of the earplug relative to a water stream to form a substantially cylindrical earplug. On the contrary, Powers not only teaches a cutting at right angles (see Figure 1), but also actually teaches against formation of a substantially cylindrical earplug at column 2, lines 24-29, which states that “The present invention is based upon the recognition that slow recovery foam could be used for manufacturing earplugs having flat sides which join at relatively shallow angles of 90 degrees or less and which can be inserted into the ear without any particular discomfort to the wearer.” These flat sides and angles are selected so as to allow for “virtually no waste” (see column 2, line 41), wherein such waste is associated with manufacture of earplugs of a “circular shape” (see column 1, lines 25-28). As such, the whole idea of Powers is to cut a sheet in *non-circular patterns* to provide *non-cylindrical* earplugs that include “three or four sides which would include a triangle, square, rectangle, parallelogram, trapezium or trapezoid” (see column 3, lines 21-25). The Figure 7 of Powers referenced by the Examiner in the Office Action shows an earplug with “sharp edges resulting from...perpendicular or sharp edges,” which are discounted when the plug is “twirled” between the thumb and forefinger of a user to form the shape shown in Figure 7 (see column 3, lines 27-32).

Accordingly Applicant respectfully asserts that Powers teaches neither a water jet cutting of circular patterns, nor a formation of an earplug of cylindrical shape, as is recited in applicant’s claim 1 and alleged by the Examiner in the Office Action. None of Smith, Baril, and Cut Smart remedies these deficiencies.

It is respectfully noted that, at page 4 of the Office Action, the Examiner alleges that the Powers, Smith, Baril, and Cut Smart may be properly modified to teach an earplug of a substantially cylindrical shape (which are well known in the art), wherein a mere change in shape does not patentably distinguish an invention. While applicant concurs with the Examiner’s statement that cylindrical earplugs are well known in the art,

Applicant respectfully points out that “cylindrical earplugs” are not claim elements for which Applicant is seeking protection. On the contrary, Applicant is seeking protection for a *method* wherein earplugs are severed from a sheet via a water jet moving in circular patterns along longitudinal extents of the earplugs. Not only is such a method not taught in Powers, Smith, Baril, and Cut Smart, but Powers actually teaches against a cutting in circular patterns in its stated selection of flat sides and angles so as to allow for “virtually no waste” (see column 2, line 41). In fact, if Powers were to be modified to teach a cutting via circular patterns as suggested by the Examiner, the resulting method would necessarily eliminate the flat sides and angles stated in Powers, thus rendering Powers inoperable and unsatisfactory for its intended purpose of allowing for “virtually no waste” via such flat sides and angles. Applicant respectfully asserts that this would render the proposed modification of Powers improper under MPEP 2143.01V.

For at least these reasons, Applicant respectfully asserts that the proposed combination of Powers, Smith, Baril, and Cut Smart does not teach or suggest all of the limitations of Applicant’s amended claim 1. Accordingly, Applicant respectfully submits that *prima facie* obviousness does not exist regarding amended claim 1 with respect to the proposed combination of Powers, Smith, Baril, and Cut Smart.

Since the proposed combination of Powers, Smith, Baril, and Cut Smart fails to teach or suggest all of the limitations of amended claim 1, clearly, one of ordinary skill at the time of Applicant’s invention would not have a motivation to modify or combine the reference, or a reasonable likelihood of success in forming the claimed invention by modifying or combining. Thus, here again, *prima facie* obviousness does not exist. *Id.*

As such, the requirements of *prime facie* obviousness does not exist regarding amended claim 1 with respect the proposed combination of Powers, Smith, Baril, and Cut Smart. Applicant respectfully submits that claim 1 are not further rejected or objected and is therefore allowable. As claims 3-10 and 16-21 depend from claim 1, they are thus correspondingly allowable. Reconsideration and allowance of claims 1, 3-10, and 16-21 is

respectfully requested.

Referring now to Applicant's amended claim 22, there is recited *inter alia*,

“maneuvering the high pressure stream to cut the foam sheet, to delimit elongated sides of the earplug extending substantially along the longitudinal length of the earplug, and to sever the earplug from the foam sheet, wherein said maneuvering comprises a substantially circular displacement of the earplug relative to said water stream, and wherein, and wherein said maneuvering comprises traversing circular patterns on the sheet to sever the earplug from the sheet.”

As is mentioned above, Powers, taken on its own or in combination with Smith, Baril, and Cut Smart, does not teach cutting circular patterns on the sheet with a water jet (see the cutting at right angles of Figure 1). Thus, for at least these reasons discussed with reference to claim 1, Applicant respectfully asserts that the proposed combination of Powers, Smith, Baril, and Cut Smart does not teach or suggest all of the limitations of Applicant's amended claim 22. Accordingly, Applicant respectfully submits that *prima facie* obviousness does not exist regarding amended claim 22 with respect to the proposed combination of Powers, Smith, Baril, and Cut Smart.

Since the proposed combination of Powers, Smith, Baril, and Cut Smart fails to teach or suggest all of the limitations of amended claim 22, clearly, one of ordinary skill at the time of Applicant's invention would not have a motivation to modify or combine the reference, or a reasonable likelihood of success in forming the claimed invention by modifying or combining. Thus, here again, *prima facie* obviousness does not exist. *Id.*

As such, the requirements of *prime facie* obviousness does not exist regarding amended claim 22 with respect the proposed combination of Powers, Smith, Baril, and Cut Smart. Applicant respectfully submits that claim 22 is not further rejected or objected and is therefore allowable. As claim 23 depends from claim 22, they are thus correspondingly

allowable. Reconsideration and allowance of claims 22-23 is respectfully requested.

Claims 11-15 are rejected under 35 U.S.C. §103(a) as allegedly being obvious in view of Powers, Smith, Baril, and Cut Smart and in further view of U.S. Patent No. 5,573,015 to Williams. Applicant respectfully traverses.

Claims 11-15 variously depend from claim 1. As Williams does not remedy the deficiencies of the proposed combination of Powers, Smith, Baril, and Cut Smart, the proposed combination of Powers, Smith, Baril, Cut Smart, and Williams does not teach every element of claims 11-15. Accordingly, Applicant respectfully submits that *prima facie* obviousness does not exist regarding claims 11-15 with respect to the proposed combination of Powers, Smith, Baril, Cut Smart, and Williams.

Since the proposed combination of Powers, Smith, Baril, Cut Smart, and Williams fails to teach or suggest all of the limitations of claims 11-15, clearly, one of ordinary skill at the time of Applicant's invention would not have a motivation to modify or combine the reference, or a reasonable likelihood of success in forming the claimed invention by modifying or combining. Thus, here again, *prima facie* obviousness does not exist. *Id.*

As such, the requirements of *prime facie* obviousness does not exist regarding amended claims 11-15 with respect the proposed combination of Powers, Smith, Baril, Cut Smart, and Williams. Applicant respectfully submits that claims 11-15 are not further rejected or objected and is therefore allowable.

Conclusion

The prior art rejections herein overcome. Entry of the present Response with Amendment and prompt issuance of a Notice of Allowance are respectfully requested.

Applicant hereby petitions for any extension of time necessary for consideration of this Response.

Please charge any fees due with respect to this Response, or otherwise regarding the application, to Deposit Account 06-1130 maintained by Applicant's attorneys.

The Office is invited to contact Applicants' attorneys at the below-listed telephone number regarding this Response or otherwise concerning the present application.

Respectfully submitted,

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